

REMARKS

I. Status of the Claims

In the Final Office Action¹ mailed July 21, 2010, the Examiner took the following actions:

(i) rejected claims 1, 14, 16, 20, 41, 55-57, 60, 61, 63, 64, 72, 73, and 82 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,791,583 B2 to Tang et al. ("*Tang*") and U.S. Patent Application Publication No. 2002/0091774 A1 Imamura et al. ("*Imamura*");

(ii) rejected claims 7, 8, 21, and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and U.S. Patent Application Publication No. 2005/0117733 A1 to Widger et al. ("*Widger*");

(iii) rejected claims 38, 43, 65, and 66 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and U.S. Patent Application Publication No. 2003/0233265 A1 to Lee et al. ("*Lee*");

(iv) rejected claims 67, 70, 71, 74-76, 83-91, and 93 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and U.S. Patent No. 6,108,688 to Nielsen ("*Nielsen*"); and

(v) rejected claim 92 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, *Nielsen*, and *Widger*.

By this Amendment, Applicants amends claims 1, 14, 67, 72, 76, 83, 89 and 91.

No prohibited new matter has been added. Claims 1, 7, 8, 14, 16, 20, 21, 38, 41-43, 55-57, 60, 61, 63-67, 70-76 and 82-93 remain pending in this application. Applicants respectfully traverse each of the rejections and submit that the pending claims are allowable over the cited prior art.

¹ The Final Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

II. Rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of: claims 1, 14, 16, 20, 41, 55-57, 60, 61, 63, 64, 72, 73, and 82 under 35 U.S.C. § 103(a) as being unpatentable over *Tang* and *Imamura*; claims 7, 8, 21, and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and *Widger*; claims 38, 43, 65, and 66 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and *Lee*; claims 67, 70, 71, 74-76, 83-91, and 93 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, and *Nielsen*; and claim 92 under 35 U.S.C. § 103(a) as being unpatentable over *Tang*, *Imamura*, *Nielsen*, and *Widger*. A *prima facie* case of obviousness has not been established.

Independent claim 1, as amended, recites a method including:

display, to a user of an instant messaging system, **a graphical user interface of an instant messaging service, the graphical user interface comprising a window** that includes a contacts list listing identifiers corresponding to multiple co-users of the instant messaging service . . .

receive a notification from an e-mail client when an email message is received from a first one of the co-users . . .

display, **within the window** that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have been sent by the first co-user to the user and remain unread by the user, **wherein the first graphical element is automatically displayed in response to the notification and independent of a selection of the identifier by the user.**

(Emphases added).

The asserted combinations of the cited references do not teach or suggest at least these features of claim 1.

Tang discloses:

As shown in FIG. 5A, John can obtain additional information about Janak's selected activities by selecting the visual representation of Janak (i.e., Janak's name) in John's contact list 60a. For example, John can select Janak's entry in the contact list 60a through a point and click operation. **Upon John's selection of Janak's entry**, an information window 62 appears on John's desktop 12a. The information window 62 includes an envelope icon 62b . . . [that] indicates that John has four unread e-mail messages from Janak. (Emphasis added, col. 11, lines 17-31)

Thus, in *Tang* an envelope icon 62b is displayed in response to a selection of visual representation in contact list 60a. Envelope icon 62b of *Tang*, however, does not constitute the claimed "first graphical element" at least because envelope icon 62b is not "automatically displayed in response to the notification and independent of a selection of the identifier by the user," as recited in amended claim 1.

There is simply no disclosure in *Tang* of receiving "a notification from an e-mail client when an email message is received from a first one of the co-users" and automatically displaying a first graphical element "in response to the notification." In addition, envelope icon 62b of *Tang* is displayed in response to a selection of a visual representation in contact list 60a, but not "independent of a selection of the identifier by the user."

Further, envelope icon 62b of *Tang* also does not constitute the claimed "first graphical element" because envelope icon 62b is not displayed "within the window" of a graphical user interface of an instant messaging service. In contrast and as disclosed in Fig. 5A of *Tang*, envelope icon 62b is displayed in a separate window 62. Page 3 of the Final Office Action acknowledges this deficiency of *Tang* and relies on *Imamura* to overcome this deficiency. Applicants submit that *Tang*, when considered alone or in

any proper combination with *Imamura*, still does not teach or suggest “display, **within the window** that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have been sent by the first co-user to the user and remain unread by the user,” as recited in claim 1 (emphasis added).

Imamura discloses “window 600 includes the names 605 of the registered users Associated with each registered user’s name is a numeral that represents the number of unread messages addressed to the respective user that are located on mail server system 200 . . . **window 600 will only appear on the display of the user interface device when the user activates the e-mail program module 36.**”

Imamura, paragraph [0053] (emphasis added).

Thus, *Imamura* discloses displaying a numeral in window 600 of an e-mail program. The numeral of *Imamura* also does not constitute the claimed “first graphical element” because the numeral is not displayed “within the window” of an instant messaging service. In contrast, the numeral is displayed in window 600 of an e-mail program.

Accordingly, *Tang* and *Imamura* do not teach or suggest each and every feature of claim 1. Moreover, *Widger*, *Lee*, and *Nielsen* also do not overcome the above-noted deficiencies of *Tang* and *Imamura*.

In view of the above differences between the subject matter of independent claim 1 and the cited references, a *prima facie* case of obviousness has not been established with respect to this claim. Independent claims 14, 67, 72, 76, 83, 89 and 91, though of different scope from claim 1 and each other, recite features similar to those discussed

above in connection with claim 1. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 14, 67, 72, 76, 83, 89 and 91 for at least similar reasons as that presented for claim 1.

Furthermore, a *prima facie* case of obviousness has not been established with respect to dependent claims 7, 8, 16, 20, 21, 38, 41-43, 55-57, 60, 61, 63-66, 70, 71, 73-75, 82, 84-88, 90, 92, and 93 at least due to their dependence from one of the independent claims, and further due to the features recited therein.

In view of the foregoing, the rejection of Applicants' claims should be withdrawn and the claims should be timely allowed.

CONCLUSION

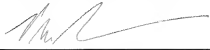
In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: 
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